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10/004,363	11/01/2001	Ali Bani-Hashemi	2001PI8496US	7290

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Siemens Corporation
Attn: Elsa Keller, Legal Administrator
Intellectual Property Department
186 Wood Avenue South
Iselin, NJ 08830

EXAMINER

MEHTA, PARIKHA SOLANKI

ART UNIT	PAPER NUMBER
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3737

MAIL DATE	DELIVERY MODE
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06/19/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/004,363

Applicant(s)

BANI-HASHEMI ET AL.

Examiner

Parikha S. Mehta

Art Unit

3737

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 7-14, 16-18 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 7-14, 16-18 and 20-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 12 April 2006 have been fully considered but they are not sufficient to overcome the Cosman (US Patent No. 6,405,072) reference. Examiner concedes that Applicant's reasoning is sufficient to overcome the arguments presented in the previous Office Action. However, upon further consideration, Examiner finds additional support in the Cosman ('072) to sufficiently anticipate Applicant's claimed subject matter. Examiner presents herein new arguments to substantiate such contentions of anticipation. Additionally, Examiner finds claims 1-3, 8 and 9 to be directed towards non-statutory subject matter, and a rejection under 35 U.S.C. 101 is accordingly presented herein.

Applicant previously disclosed an intent to defer response to the previous double patenting rejections of claims 1-3, 5, 7-14, 16-8 and 20-23 until those claims are found to be in condition for allowance. Examiner acknowledges Applicant's right to defer filing a Terminal Disclaimer or arguments sufficient to overcome the double patenting rejections. However, until Applicant files such a disclaimer or sufficiently persuasive arguments, the rejections must be maintained and are therefore reiterated herein.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 3737

3. Claims 1-3, 5, 7-14, 16-18 and 20-23 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,535,574. Although the conflicting claims are not identical, they are not patentably distinct from each other because they represent alternate variations and groupings of the same invention.

4. Claims 1-3, 5, 7-14, 16-18 and 20-23 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of US Patent No. 7,016,522. Although the conflicting claims are not identical, they are not patentably distinct from each other because they represent alternate variations and groupings of the same invention.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-3 and 8-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-3 and 8-9 are directed toward a method for planning radiation treatment, the steps of which do not result in any kind of physical transformation, nor does it provide a useful, tangible and concrete result. Examiner suggests that Applicant amend claim 1 to possibly include steps for displaying an image or message indicating whether the first and second positions sufficiently correlate, or steps for treating the patient based upon the determined radiation plan, or some other such amendment sufficient to cure the statutory deficiencies of the instant application. For further reference regarding the definition of statutory subject matter as set forth by the USPTO, Examiner directs Applicant's attention to the USPTO published Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility published on 26 October 2005 :

http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf

Specification

7. The disclosure is objected to because of the following informalities: on page 2, line 2 of the instant specification, the underlined portions of the phrase "Application Serial No. _____, filed _____" should be replaced with actual patent or application numbers.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-3, 5, 7, 9-14, 16-18 and 20-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Cosman (US Patent No. 6,405,072), hereinafter Cosman ('072).

Regarding claims 1, 5, 12-14 and 17, Cosman ('072) discloses a system and method for planning radiation treatment including means and steps for using a camera (photogrammetry device) to acquire a first three-dimensional surface data representing a portion of a patient's body while the patient is in a first position during a CT scan (Figs. 1-3 & 7, col. 10 lines 19-37), acquiring second data independent from the first data and representing at least one internal three-dimensional portion of the patient's body while the patient maintains the first position (col. 9 lines 46-65), determining a location of an isocenter of the patient based on the second data (col. 8 lines 20-30, col. 11 lines 1-11), converting the first three-dimensional surface data (camera space) to a coordinate frame of the patient (scan space) based on the location of the isocenter (col. 3 lines 26-67, col. 6 lines 39-59, col. 15 line 8-col. 16 line 42), acquiring third 3D data representing a portion of the patient's body while the patient is in a second position maintained for delivery of radiation treatment, converting the third 3D data to a coordinate frame of the radiation treatment station, and determining if the first and second positions correspond by directly comparing the converted first 3D data to the converted third 3D data (col. 10 lines 37-57). The system of Cosman includes a controller as claimed in the instant application (col. 6 lines 50-59, col. 10 lines 37-50). Cosman ('072) additionally moves the patient to align the target with the radiation beam, which constitutes moving the patient so that the second position corresponds to the first position if the two positions are not already corresponding as claimed in the instant application (col. 10 lines 50-53).

Regarding claims 2, 14 and 18, Cosman ('072) discloses means and steps for determining a radiation treatment plan based on the first and second data, as well as data representing the camera space, couch position, and gantry position, which constitutes data representing a physical layout of the radiation treatment station as claimed in the instant application (col. 5 lines 8-45).

Art Unit: 3737

Regarding claim 3, Cosman ('072) states that "the controller 38 can move sequentially to different target positions within a generalized target volume" (col. 7 lines 18-24), which constitutes means and steps for determining a position of the radiation treatment device that will avoid the patient's body and that will allow irradiation of apportion of at least one internal portion of the patient's body as claimed in the instant application.

Regarding claim 7, Cosman ('072) discloses that the controller incorporates structure to record and verify positional relationships such as that between the radiation beam and the patient, and that it further manipulates the status of the beam during treatment (col. 6 lines 50-59), which constitutes changing the radiation treatment plan based on differences between the first and second positions as claimed in the instant application.

Regarding claims 9 and 20, Cosman ('072) teaches computerized means and steps for determining whether the patient's body has changed greater than a threshold amount and obtaining additional surface data in order to re-align the target position (col. 16 line 60-col. 17 line 47).

Regarding claims 10, 11, and 21-23, Cosman ('072) discloses means and steps for continuously monitoring the location of the radiation target during treatment to maintain confirmation of its position relative to the beam, and that the system can detect tidal movement such as respiratory movement (col. 7 lines 18-25). Furthermore, as discussed for claim 7, Cosman ('072) discloses turning the radiation beam on only when it is positioned over the target (col. 6 lines 50-59). In combination, these disclosures constitute acquiring a fourth and fifth surface data set and activating the radiation beam only if it is determined that the patients' position corresponds to a point in a cycle of body motion specified by the plan as claimed in the instant application.

Regarding claim 16, Cosman ('072) shows that first and second cameras (photogrammetry devices) may be the same device (Figs. 5 & 6).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cosman ('072). Cosman ('072) substantially teaches all features of the present invention as previously discussed for claim 1, but

Art Unit: 3737

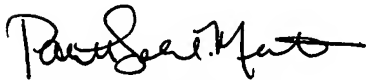
does not explicitly teach determining whether the patient represented by the first data is different from the patient represented by the third data. As previously stated, Cosman ('072) does teach that the method and system are capable of verifying the position of the radiation target prior to delivering treatment (col. 6 lines 50-59, col. 10 lines 37-57). One of ordinary skill in the art at the time of invention would find it obvious, then, that the system and method of Cosman ('072) would inadvertently detect whether the patient being radiated is different from the patient of the initial scan data, since the positions of the radiation target would necessarily be different for two separate patients.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Parikha S. Mehta whose telephone number is 571.272.3248. The examiner can normally be reached on M-F, 8 - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571.272.4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Parikha Solanki Mehta

Examiner – Art Unit 3737


ELENI MANTIS MERCADER
SUPERVISORY PATENT EXAMINER